

Application No. 10/501,431
Amendment dated June 16, 2005
Reply to Restriction/Election requirement of 06/09/2005

REMARKS/ARGUMENTS

In the Election/Restriction requirement made by the Examiner on 06/09/2005, the Examiner held that, while the purported inventions of Group II (claims 1-14, drawn to "a method for soldering a first substrate ..."), and Group I (claims 15-16, drawn to "a semiconductor package") are related as process of making and product made, the inventions are nevertheless "distinct, each from the other," because,

"unpatentability of the group I invention would not necessarily imply the unpatentability of the Group II invention, since the device of the Group I invention could be made by processes materially different from the group II invention, for example, the semiconductor package can be formed by methods other than those disclosed in the invention." (Emphasis added.)

The above holding, together with the reasoning upon which it is based, are respectfully traversed, for the following reasons:

It should be noted that each of the claims of Group I are cast in dependent form and thus, necessarily incorporate all of the "process" limitations of the respective base (and any intervening) claims from the claims of Group II from which they depend. *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992). Accordingly, it is not seen how, in the first instance, that the "unpatentability" of the Group I invention, as claimed, would not necessarily entail the unpatentability of the Group II invention, or stated alternatively, how the Group I invention could be patentable, without the base claims from which they depend also being patentable. Neither is it seen, in the second instance, how the device of the Group I invention, as claimed, could be made by processes that are "materially different" from the process limitations from Group II that are expressly incorporated therein. *Id.* The Examiner's reasoning thus stands both the statute and ordinary logic on their head.

Additionally, it should be noted that this Application corresponds to the national stage of PCT/US02/06183, and accordingly, was and is subject to PCT Rule 13, relating to "Unity of Invention" (MPEP Appendix T, Patent Cooperation Treaty). Rule 13.1 provides that,

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention'). (Emphasis added.)

PCT Rule 13.4 further provides that,

"Dependent Claims – Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim. even where the features of any dependent claim could be considered as constituting in themselves an invention." (Emphasis added.)

Application No. 09/950,513
Amendment dated November 25, 2004
Reply to Office Action of August 25, 2004

The "PCT Applicant's Guide," Vol. 1, International Phase, further provides, in part,

"... Rule 13 is construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:


"(iii) in addition to *an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product*" (Emphasis added.)

The Applicant respectfully submits that, if the international Rules permit the inclusion of either a dependent claim or an independent claim for a product, together with an independent claim for the process specially adapted for the manufacture of it, then the rules applicable to this application at the national phase should be no more restrictive, nor afford any less rights to the Applicant, than those applicable at the international stage.

CONCLUSION

For the reasons stated above, it is respectfully submitted that the Examiner's Election/Restriction requirement of 06/09/2005 is both erroneous and *ultra vires*, and accordingly, should be withdrawn.

If there are any questions regarding this amendment, the Examiner is invited to call the undersigned at (310) 439-1800.

Certification of Facsimile Transmission	
I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.	
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Respectfully submitted,



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